

REMARKS

This Amendment responds to the final Office action dated May 18, 2006. As indicated in that action, claims 1-11, 13-19, and 21-51 are pending in the present application and currently stand rejected. By this Amendment, claims 1-10 are cancelled, leaving claims 11, 13-19, and 21-51 unchanged. No new matter has been added by this Amendment. Applicants respectfully request reconsideration of the rejections and submit claims 11, 13-19, and 21-51 for further consideration.

I. Claim Rejections – 35 U.S.C. § 103

A. Claims 1-10

Claims 1-10 are cancelled herein, rendering the Examiner's rejections of these claims moot. Applicants reserve the right to pursue the subject matter of claims 1-10 at a later date, such as in a continuation application.

B. Claims 11, 13-19, and 21-51 Are Allowable Because Santana Is Not a Valid Reference Under 35 U.S.C. § 103(a)

Claims 11, 13-19, and 21-51 stand rejected based on U.S. Patent No. 6,924,620 ("Santana") in combination with other references. Applicants respectfully point out that **Santana is not a valid reference under 35 U.S.C. § 103(a) because 35 U.S.C. § 103(c) applies.** See 35 U.S.C. § 103(c); MPEP §§ 706.02(l) and 706.02(l)(1)-(3).

Applicants' Statement Concerning Common Ownership is as follows:

STATEMENT CONCERNING COMMON OWNERSHIP

The present Application No. 10/721,800 and Santana (U.S. Patent No. 6,924,620) were, at the time the invention of Application No. 10/721,800 was made, owned by Milwaukee Electric Tool Corporation.

Though not required by the MPEP, Applicants submit for the Examiner's reference copies of the official assignment recordation documents for the present application and for Santana. The assignments to Milwaukee Electric Tool Corporation for the present application are recorded at reel 015129, frame 0549 and reel 015129, frame 0603. The assignments to Milwaukee Electric Tool Corporation for Santana are recorded at reel 013154, frame 0424.

For at least the above reasons, Santana is disqualified from being used in a rejection under 35 U.S.C. § 103(a) against the claims of the present application. Therefore, the rejections of claims 11, 13-19, and 21-51 under 35 U.S.C. § 103(a) are overcome, and claims 11, 13-19, and 21-51 should be allowed.

II. Conclusion

In light of the amendments and remarks above, Applicants respectfully request entry of this Amendment and the allowance of claims 11, 13-19, and 21-51. The undersigned is available for telephone conference at any time.

Respectfully submitted,



Carlo M. Cotrone
Reg. No. 48,715

Docket No. 066042-9537-00
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Suite 3300
Milwaukee, Wisconsin 53202-4108
(414) 271-6560



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RECORDATION DATE: 09/10/2004

REEL/FRAME: 015129/0603
NUMBER OF PAGES: 4

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

JOHNSON, TODD W.

DOC DATE: 09/02/2004

ASSIGNOR:

GRZYBOWSKI, DENNIS J.

DOC DATE: 09/07/2004

ASSIGNOR:

KUBALE, MARK A.

DOC DATE: 09/02/2004

ASSIGNOR:

ROSENBECKER, JAY J.

DOC DATE: 09/02/2004

ASSIGNOR:

MEYER, GARY D.

DOC DATE: 09/07/2004

ASSIGNOR:

ZEILER, JEFFREY M.

DOC DATE: 09/02/2004

JP

015129/0603 PAGE 2

ASSIGNOR:

GLASGOV, KEVIN L.

DOC DATE: 09/03/2004

ASSIGNEE:

MILWAUKEE ELECTRIC TOOL
CORPORATION
13135 WEST LISBON ROAD
BROOKFIELD, WISCONSIN 53005

SERIAL NUMBER: 10721800

FILING DATE: 11/24/2003

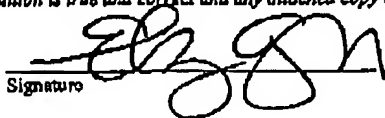
PATENT NUMBER:

ISSUE DATE:

TITLE: BATTERY PACK

DOROTHY RILEY, PARALEGAL
ASSIGNMENT DIVISION
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FORM PTO-1595 1-31-92		U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office	
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TO: ASSIGNMENT DIVISION - U.S. PATENT AND TRADEMARK OFFICE SENT VIA FACSIMILE TO 703-306-5995			
Please record the attached Assignment document.			
1. Name of conveying party(ies): Todd W. Johnson, Dennis J. Grzybowski, Mark A. Kubale, Jay J. Rosenbecker, Gary D. Meyer, Jeffrey M. Zeller and Kevin L. Glasgow		2. Name and address of receiving party(ies): Name: Milwaukee Electric Tool Corporation Address: 13135 West Lisbon Road Brookfield, WI 53005	
3. Nature of Conveyance: <input checked="" type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Security Agreement <input type="checkbox"/> Change of Name <input type="checkbox"/> Other: Execution Date: September 2, 2004, September 3, 2004 and September 7, 2004, respectively		Additional name(s) & address(es) attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No	
4. Application number(s) or patent number(s): A. Patent Application No.(s) 10/721,800 Filed: 11/24/2003		B. Patent No.(s)	
Additional numbers attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No			
5. Name and address of party to whom correspondence concerning document should be mailed: David B. Smith Michael Best & Friedrich LLP 100 East Wisconsin Avenue Milwaukee, Wisconsin 53202-4108 Phone: (414) 271-6560		6. Total number of applications and patents involved: 1	
		7. Total fee (37 CFR 3.41):\$ 40.00 <input type="checkbox"/> Enclosed <input checked="" type="checkbox"/> Charge fee to Deposit Account	
		8. Deposit account number: 13-3080	
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9. Statement and signature: To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.			
Elizabeth A. Egasti (Reg. No. 54,615) Name of Person Signing		Signature  Date September 10, 2004	
Attorney File 066042-9537-00		Total number of pages including cover sheet, attachments, and document: 4	
CPLS No. 0631-0011 (exp. 4/04)			

00412200 000000 10721800

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SEPTEMBER 15, 2004

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RECORDATION DATE: 09/10/2004

REEL/FRAME: 015129/0549
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

SCHEUCHER, KARL F.

DOC DATE: 08/19/2004

ASSIGNEE:

MILWAUKEE ELECTRIC TOOL
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13135 WEST LISBON ROAD
BROOKFIELD, WISCONSIN 53005

SERIAL NUMBER: 10721800
PATENT NUMBER:
TITLE: BATTERY PACK

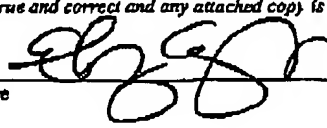
FILING DATE: 11/24/2003
ISSUE DATE:

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015129/0549 PAGE 2

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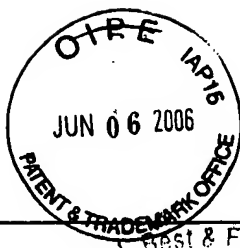
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1. Name of conveying party(ies): Karl F. Scheucher		2. Name and address of receiving party(ies): Name: Milwaukee Electric Tool Corporation Address: 13135 West Lisbon Road Brookfield, WI 53005 Additional name(s) & address(es) attached? _ Yes <input checked="" type="checkbox"/> No	
3. Nature of Conveyance: <input checked="" type="checkbox"/> Assignment _ Merger <input type="checkbox"/> Security Agreement _ Change of Name <input type="checkbox"/> Other: Execution Date: August 19, 2004			
4. Application number(s) or patent number(s): A. Patent Application No.(s) 10/721,800 Filed: 11/24/2003		B. Patent No.(s) 1	
Additional numbers attached? _ Yes <input checked="" type="checkbox"/> No			
5. Name and address of party to whom correspondence concerning document should be mailed: David B. Smith Michael Best & Friedrich LLP 100 East Wisconsin Avenue Milwaukee, Wisconsin 53202-4108 Phone: (414) 271-6560		6. Total number of applications and patents involved: 1	
		7. Total fee (37 CFR 3.41):.....\$ 40.00 _ Enclosed <input checked="" type="checkbox"/> Charge fee to Deposit Account	
		8. Deposit account number: 13-3080	
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9. Statement and signature. <i>To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.</i> Elizabeth A. Eassey (Reg. No. 54,635) Name of Person Signing Signature  Date September 10, 2004 Attorney File 066042-9537-00 Total number of pages including cover sheet, attachments, and document: 3			
OMB No. 0651-0011 (exp. 4/94)			

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RECORDATION DATE: 07/25/2002

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NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

SANTANA, GEORGE L.JR.

DOC DATE: 07/23/2002

ASSIGNEE:

MILWAUKEE ELECTRIC TOOL
CORPORATION
13135 WEST LISBON ROAD
BROOKFIELD, WISCONSIN 53005

SERIAL NUMBER: 10202693

FILING DATE: 07/25/2002

PATENT NUMBER:

ISSUE DATE:

JOANN STEWART, EXAMINER
ASSIGNMENT DIVISION
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08-08-2002

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To the Assistant Commissioner for Patents. Please record and index the attached original documents or copy thereof.

<p>1. Name of conveying party(ies): George L. Santana, Jr.</p> <p style="text-align: center;">MRD 7/25/02</p>		<p>2. Name and address of receiving party(ies):</p> <p>Name: Milwaukee Electric Tool Corporation</p> <p>Address: 13135 West Lisbon Road Brookfield, WI 53005</p> <p>Additional name(s) & address(es) attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No</p>				
<p>3. Nature of Conveyance: Assignment</p> <p>Execution Date: <u>July 23, 2002</u></p>						
<p>4. This document is being filed together with a new application. The execution date of the application is: <u>July 23, 2002</u></p> <p style="text-align: center;">10202693</p> <p style="text-align: center;">NO ADDITIONAL NUMBERS ATTACHED.</p>						
<p>5. Name and address of party to whom correspondence concerning document should be mailed:</p> <p>David B. Smith Michael Best & Friedrich LLP 100 East Wisconsin Avenue Milwaukee, Wisconsin 53202-4108</p> <p>Phone: (414) 271-6560</p>		<p>6. Total number of applications and patents involved: <u>1</u></p> <p>7. Total fee (37 CFR 3.41):.....\$ 40.00</p> <p><input checked="" type="checkbox"/> Enclosed</p> <p><input checked="" type="checkbox"/> Deficiencies in fee charged to Deposit Account</p> <p>8. Deposit account number: <u>13-3080</u></p>				
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<p>9. Statement and signature.</p> <p><i>To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.</i></p> <table border="0" style="width: 100%;"><tr><td style="width: 40%;"><u>Edward R. Lawson Jr. (Reg. No. 41,931)</u> Name of Person Signing</td><td style="width: 30%; text-align: center;"> Signature</td><td style="width: 30%; text-align: right;"><u>July 25, 2002</u> Date</td></tr></table> <p style="text-align: center;">Total number of pages including cover sheet, attachments, and document: <u>3</u></p>				<u>Edward R. Lawson Jr. (Reg. No. 41,931)</u> Name of Person Signing	 Signature	<u>July 25, 2002</u> Date
<u>Edward R. Lawson Jr. (Reg. No. 41,931)</u> Name of Person Signing	 Signature	<u>July 25, 2002</u> Date				
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